

REMARKS

Claims 29, 31-33, 35 and 36 remain herein. Claims 30 and 34 have been canceled without prejudice or disclaimer.

1. Claim 33 was rejected for alleged obviousness type double patenting (OTDP) over claim 3 of MEI's commonly owned U.S. Patent No. 6,611,820. Applicants herewith file a terminal disclaimer to moot this OTDP rejection.

2. Claims 29, 32, 33 and 36 were rejected under 35 U.S.C. § 102 (b) over O'Boyle '329. O'Boyle '329 generally relates to an automated hologram verification system on a card with a magnetic stripe (*e.g.*, credit card). The Office Action alleges that a conventional credit card verification system describes the elements recited in claims 29 and 33. See O'Boyle '329 col. 1, lines 66 – col. 2, line 11.

O'Boyle '329 fails to disclose or suggest "said identification information recorded in the form of stripe patterns extending along a radius of the optical disk," as recited in claims 29 and 33. As shown below in Fig. 5 of O'Boyle, an optical holographic image 34 is overlapped with the magnetic stripe on the substrate 30, and the image 34 do not extend along a radius of an optical disk, as required by claim.

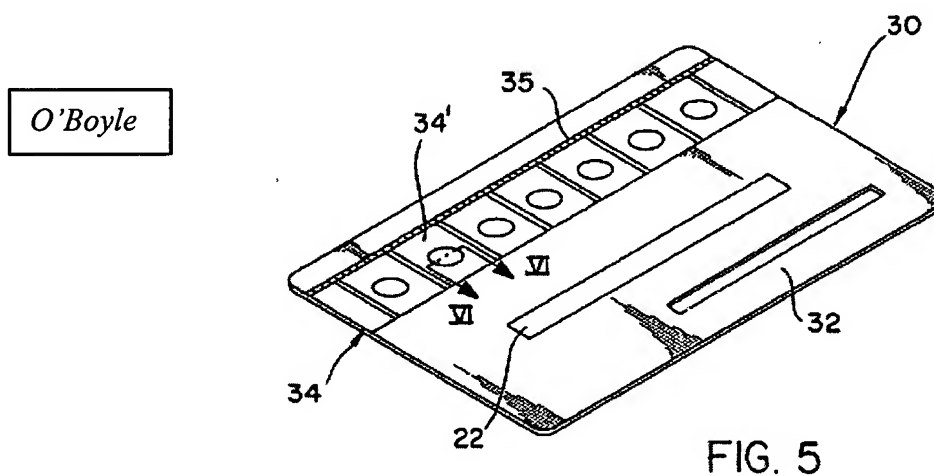
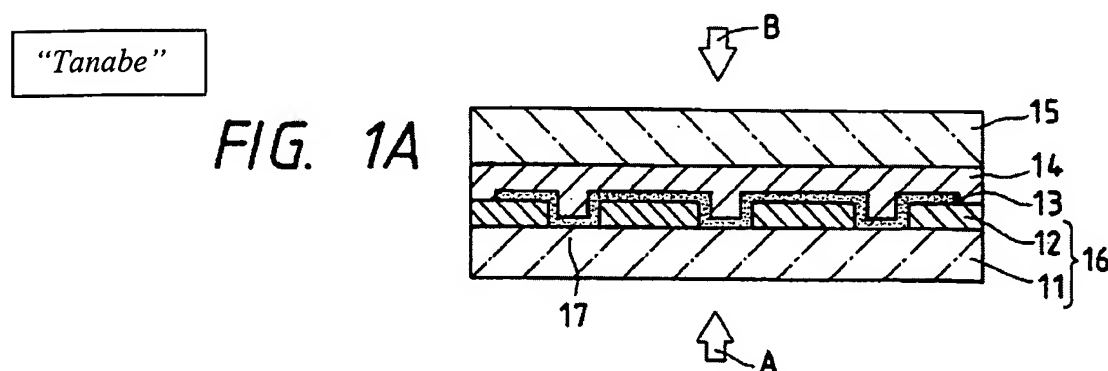


FIG. 5

For all the foregoing reasons, there is no disclosure or teaching in O'Boyle '329 of all elements of applicants' presently claimed invention. Accordingly, O'Boyle '329 is not an adequate basis for rejection of applicants' claims under § 102. Nor is there any disclosure in O'Boyle '329 that would have suggested applicants' claimed invention to one of ordinary skill in this art. Reconsideration and withdrawal of these rejections are respectfully requested.

3. Canceled claims 30 and 34, whose limitations have been incorporated into claims 29 and 33, respectively, were rejected under 35 U.S.C. § 103 (a) over O'Boyle and Tanabe '767.

Deficiencies of O'Boyle '329 have been discussed above. Tanabe '767 likewise fails to teach or suggest "said identification information recorded in the form of stripe patterns extending along a radius of the optical disk," as recited in claims 29 and 33. Tanabe '767 relates to an optical recording medium and a process for producing the recording medium. Tanabe '767 utilizes an optical recording medium with pre-pit layers, as shown below in Fig. 1A. See Tanabe col. 7, lines 3-16.



Tanabe, however, fails to disclose that the pre-pit region extends along a radius of the optical disk. Rather, in Tanabe, tracks formed in the pre-pit region are formed concentrically. See Tanabe col. 26, lines 1-4; col. 37, lines 26-32.

Further, the Office Action fails to state any rationale for combining O'Boyle and Tanabe '767. One of ordinary skill would not have combined the two references in the manner suggested by the Office Action.

As discussed above, Tanabe '767 relates to an optical recording medium and a process for producing the recording medium. Tanabe '767 utilizes an optical recording medium with layered substrates, as shown in Fig. 1A of Tanabe. See Tanabe col. 7, lines 3-16.

On the other hand, O'Boyle '329 relates to an automated holographic optical recognition system. An optical holographic image 34 is overlapped with the magnetic stripe on the substrate 30, as shown in Fig. 5 of O'Boyle. Because the hologram is overlapped with the magnetic layer, O'Boyle states that the layers must be configured specifically, as shown in Fig. 6 of O'Boyle. See O'Boyle '329, col. 6 line 34 – col. 7, line 19.

In view of these disclosures, one of ordinary skill would not have been led to combine the stripe patterns of Tanabe '767 into the substrate of O'Boyle '329. Such modifications to O'Boyle '329, by adding the stripe patterns of Tanabe '767, "cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." See MPEP §§2143.01; 2145(III); 2145(X)(D). Adding the stripe patterns of Tanabe '767 would disrupt the layered structure of O'Boyle '329. Incorporation of such stripe patterns would likely materially interfere with the operation of O'Boyle '329.

Thus, there is no disclosure or teaching in O'Boyle '329 and Tanabe '767 of all elements of applicants' claimed invention. Nor is there any disclosure or teaching in O'Boyle '329 and Tanabe '767 that would have suggested applicants' claimed invention to one of ordinary skill in the art. Still further, there is no disclosure or teaching in O'Boyle '329 and Tanabe '767 that would have suggested the desirability of combining any portions thereof effectively to anticipate or render obvious applicant's claimed invention. Accordingly, allowance of claims 29 and 33 are

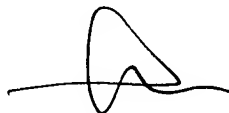
respectfully requested and, claims 31 and 35 are patentable by virtue of their dependency from claims 29 and 33, respectively.

4. Claims 30, 31, 34 and 35 are rejected under 35 U.S.C. § 103 (a) over O'Boyle '329, Tanabe '767 and Kobori '552. Kobori '552 is cited for allegedly describing a pre-pit region in the recording medium, but fails to make up for the deficiencies of O'Boyle '329 and Tanabe '767 noted above. Thus, claims 30, 31, 34 and 35 should be patentable over the cited references for the reasons clearly stated above herein.

Accordingly, all claims 29, 31-33, 35 and 36 are now fully in condition for allowance and a notice to that effect is respectfully requested. The PTO is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293. If further amendments would place this application in even better condition for issue, the Examiner is invited to call applicants' undersigned attorney at the number listed below.

Respectfully submitted,

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